



Patent
Attorney's Docket No. 1034008-000061

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Steve J. Karlik et al.) Group Art Unit: 1644
Application No.: 10/763,424) Examiner: Maher M. Haddad
Filed: January 26, 2004) Confirmation No.: 6792
For: COMPOSITION FOR AND)
TREATMENT OF DEMYELINATING)
DISEASES AND PARALYSIS BY)
ADMINISTRATION OF)
REMYELATING AGENTS)

RESPONSE TO RESTRICTION/ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Office Action of December 30, 2005, the Office sets forth a restriction requirement between ten groups of claims. Irrespective of which group is elected, the Examiner further requires identification of a single disclosed species under 35 U.S.C. § 121.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action.

Applicants respectfully assert that the inventions of Groups 1-X should properly be examined together. Applicants respectfully submit that the inventions of Groups I-X are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple

applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the five inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants indicate below an election of one group for examination. As such, Applicants elect, with traverse, to prosecute the invention of Group I, namely claims 1-24 and 46-59, drawn to a method of promoting remyelination of nerve cells or reversing paralysis in a mammal comprising administering a remyelinating agent, for prosecution in the above-identified application.

The Examiner also requires identification of a single disclosed species under 35 U.S.C. § 121. As Applicants have elected Group I, the Office requires the election of a species. With regard to this election of species, Applicants elect, with traverse, natalizumab or immunologically active fragment thereof as the agent, and multiple sclerosis as the condition, for the purposes of searching only. It is believed that claims 1-24 and 46-59 within the elected group (Group I) are readable upon the elected species of natalizumab or immunologically active fragment thereof as defined above. It is believed that claims 1-4 and 46-47 within the elected group (Group I) are readable upon the elected species of multiple sclerosis thereof as defined above.

Applicants have no intention of abandoning any non-elected subject matter and expressly reserve the right to file one or more continuation and/or divisional applications directed to the non-elected subject matter.

Applicants earnestly solicits favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BUCHANAN INGERSOLL PC

(INCLUDING THE ATTORNEYS FROM BURNS DOANE SWECKER & MATHIS)

Date: February 27, 2006

By:


Deborah H. Yellin
Registration No. 45,904

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620